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EXAMINER	
KIM, CHONG HWA	
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD H. HALL and THEODORE W. SELBY

Appeal 2005-1648
Application 09/172,577
Technology Center 3600

Decided: April 14, 2008

Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Richard H. Hall and Theodore W. Selby (Appellants) filed a Request for Rehearing (hereinafter "Request") under 37 C.F.R. § 41.52 of the Decision mailed December 22, 2005 (hereinafter "Decision"). In the

Decision, a prior panel[1] (1) reversed the rejection of claims 16, 17, 19, 20, 39, 42, 43, 46, and 47 under 35 U.S.C. § 112, first paragraph, and the rejections under 35 U.S.C. § 103(a) of claims 16, 17, 39, and 50 as unpatentable over Elizabeth (US 3,617,580) in view of Fujiyama (JP 2-82304), claims 19, 20, 42, 43, 51-53, and 61 as unpatentable over Elizabeth in view of Fujiyama and Gast (US 5,649,995), and claims 46 and 47 as unpatentable over Elizabeth in view of Fujiyama, Gast, and Tremain (US 4,594,080) and (2) sustained the rejection of claim 16 under 35 U.S.C. § 102(b) as anticipated by Kopel (US 4,561,393).

Appellants argue that the prior panel misapprehended or overlooked the fact that "claim 16 requires a truly vented, not a sealed, system, in contrast to the sealed system of Kopel (Request 1-2). In support of their argument, Appellants urge:

> The word, "vent," is an ancient word that comes as an alteration from the French, "vent," with roots in the Latin, "ventus," both meaning wind. Thus, implied by definition in a vented space is entry of wind, from external the system. It is in view of such a condition, by which oxygen can enter into the generally enclosed space, that the inert gas blanket is provided. Note that the claim refers to control of oxidative degradation.

(Request 1.)

Appellants' claim 16 is broader than their urged construction of that claim. Specifically, as pointed out on page 7 of the Decision, "claim 16 pertains to a method involving a 'vented space in a working machine,' not a working machine which is vented to the ambient environment." Relying on

[1] Judges Frankfort, McQuade, and Nase of the original panel have subsequently retired from the Board.

their findings, particularly Kopel's description (col. 2, l. 50 to col. 3, l. 8; fig. 2) reproduced on pages 8 and 9 of the Decision, the prior panel appropriately determined:

> The method recited in claim 16 relates to a vented space in a working machine. The reservoir chamber 120 in Kopel's piston-shell 116, which contains the pressurized inert gas and the hydraulic fluid 124, constitutes such a space as it is vented by the check valve. Claim 16 does not contain any limitation which excludes, or is otherwise inconsistent with, the overall sealed nature of Kopel's valve lifter.

(Decision 9-10.)

In light of the above, Appellants' argument in the Request does not persuade us that the prior panel erred in sustaining the rejection of claim 16 under 35 U.S.C. § 102(b) as anticipated by Kopel.

Appellants query whether the statement that "[c]laim 16 does not contain any limitation which excludes, or is otherwise inconsistent with, the overall sealed nature of Kopel's valve lifter" (Decision 10) is an authorization, pursuant to 37 C.F.R. § 41.50(c), to amend claim 16 to overcome the anticipation rejection (Request 2-3). 37 C.F.R. § 41.50(c) (2005), as in effect at the time of the Decision and as in effect at the present time (37 C.F.R. § 41.50(c) (2007), provides that "[t]he opinion of the Board may include an explicit statement of how a claim on appeal may be amended to overcome a specific rejection." We find in the sentence quoted by Appellants no explicit statement of how claim 16 may be amended to overcome the anticipation rejection, and we include no such explicit statement herein.

Appellants also suggest that "the Board may wish to address in detail the Examiner's rejection of claims 20 and 51-53 under 35 [U.S.C. §] 112, first paragraph, with respect to the recitation, 'without the presence of said inert gas blanket …'" (Request 3). The Examiner withdrew the rejection of claims 20 and 51-53 grounded on the position that the limitation "without the presence of said inert gas blanket, the engine oil would present properties of needing to be changed after a few thousand miles of use in said internal combustion engine" is new matter (Answer 4-5). Accordingly, that issue was not before the prior panel or addressed in the Decision and thus cannot be raised in the Request for Rehearing of the Decision.

CONCLUSION

In light of the above, Appellants' Request fails to persuade us that the prior panel erred in affirming the rejection of claim 16 under 35 U.S.C. § 102(b) as anticipated by Kopel. Therefore, we have granted Appellants' Request to the extent that we have reconsidered the Decision in light of the arguments made therein, but have denied the Request with respect to making any modification to the Decision. The rejection of claim 16 under 35 U.S.C. § 102(b) as anticipated by Kopel stands affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

DENIED

vsh

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